



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,416	07/08/2002	Joseph Simcha Wolnerman	082864-000000US	8949

7590

06/11/2003

Joe Liebeschuetz
Townsend & Townsend & Crew
8th Floor
Two Embarcadero Center
San Francisco, CA 94111-3834

EXAMINER

PATTEN, PATRICIA A

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/069,416

Applicant(s)
Wolnerman, J.S.

Examiner
First Last

Art Unit
1234



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 7, 2003
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above, claim(s) 16-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

Art Unit: 1654

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I in Paper No. 11 is acknowledged. The traversal is on the ground(s) that the Groups contain a Special technical feature. This is not found persuasive because 1) all of the claims do not contain an active agent containing 70% monoterpenes: for example, claim 2 recites wherein the active ingredient contains 60% limonene which is not a monoterpene with 3 unsaturations. Further, the salts as found in claim 1 are not found in some of the dependant claims, because some of the dependant claims recite carnallite. Carnallite is a specific formation of salt, $\text{KMgCl}_3 \cdot 6\text{H}_2\text{O}$ which does not 'include' the salts of claim 1. Thus, the Special Technical feature lacking in the claims here is two-fold.

The requirement is still deemed proper and is therefore made FINAL.

Upon further consideration, it is deemed that an election of species with regard to the elected Group of Claims 1-15 is in order:

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Art Unit: 1654

The species are as follows:

active ingredient: Please select *one* active ingredient for examination on the merits. For example, an active ingredient comprising 70% monoterpenes with three unsaturations, a single type of extract (i.e., an aromatic oil from a particular species of fruit), the type of oil (aromatic or ether), an active ingredient comprising 60% of limonene, or a particular mixture such as myrcene and limonene for example.

salt: Please elect one type of salt or one combination, i.e., NaCl or NaCl + MgCl₂.

Applicant is required, in reply to this action, to elect a single species of active ingredient and salt to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Art Unit: 1654

The claims are deemed to correspond to the species listed above in the following manner:

The following claim(s) are generic: 1-15.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: As indicated *supra*, the 'active ingredient' is not consistent throughout the claims. In the broad claim, Applicant claims a composition comprising an active ingredient comprising at least 70% by weight monoterpenes with three unsaturations, while other claims recite an active ingredient which contains 60% limonene (does not contain three unsaturations). Further, some dependant claims are drawn to 'wherein said salt is included in the form of carnallite. An embodiment of the special technical feature is the presence of a salt selected from magnesium bromide, sodium chloride, magnesium chloride, calcium chloride and mixtures thereof. The recitation of 'carnallite' in some of the dependant claims creates lack of consistency with regard to the 'Special Technical feature' (please also see explanation *supra*).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

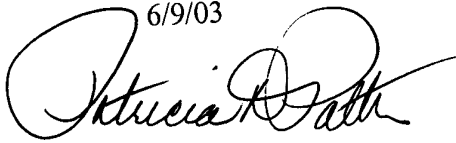
Application/Control Number: 10/069,416

Art Unit: 1654

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Patricia Patten, whose telephone number is (703)308-1189. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. The official After final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

6/9/03

Patricia Patten